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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/606,929	06/29/2000	Reza Jalili	P/2832-14	6705

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NEW YORK, NY 100368403

EXAMINER
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PATEL, JAGDISH

ART UNIT	PAPER NUMBER
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3624

DATE MAILED: 07/18/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/606,929

Applicant(s)

JALILI, REZA

Examiner

JAGDISH N PATEL

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on 29 June 2000.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-37 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-37 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3 6) ☐ Other: \_\_\_\_\_

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## DETAILED ACTION

### *Claim Objections*

1. Claims 1-15 are objected to because of the following informalities:

The term "customer" and "purchaser" are used interchangeably. It is assumed that these two are same entity. Appropriate correction is required.

Claims 4, 10-13 and 15 refer to "the processing center". There is no reference to it in the parent claims. It is assumed to be "the transaction center".

Similar deficiency also exists in claims 18-20

Appropriate correction is required.

Claim 33 uses terms "customer" and "caller" interchangeably. A clear distinction should be made between a caller and a customer. Retrieving step should more appropriately recite "authenticated registered customer" in place of "identified telephone number".

### *Double Patenting*

2. rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

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A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

3. Claims 16-20 are rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 16-20 of prior U.S. Patent No. 6,088,683. This is a double patenting rejection.

4. Claims 1-15 are rejected under the judicially created doctrine of double patenting over claims 1-15 of U. S. Patent No. 6,088,683 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows:

Claims 1-15 of the instant application recites a method of completing a purchase transaction utilizing a first electronic network and a second electronic network. The relationship of the "transaction center" of the instant application to the customer (alternatively also termed "the purchaser" in claim 1) and the merchant are recited as (1) the customer's financial information is registered in the transaction center (step (a) of the

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reference patent) (2) a good or service is ordered by the customer from a merchant (step (b) of the reference patent), identifying information pertaining to the customer is supplied by the customer to the merchant (step (c) of the reference patent), transaction center receiving information pertaining to the purchase (step (d) of the reference patent).

In view of the teachings of the reference patent as analyzed above, it would have been obvious to one of ordinary skill in the art at the time of the application to modify the patent reference to obtain the claimed invention to realize the benefits of achieving secure transmission of the customer's payment over a secure network (second network), while still ordering the purchase using a first network such as the Internet. All other steps of claim 1 (step (c) and (d) being substantially identical to the steps ((e) and (f) of claim 1 of the reference patent).

Note that dependent claims 2-15 correspond to claims 2-15 of the reference patent where no patentable distinction is made between "the transaction center" of the current application and "the central processing center" of the reference patent.

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application which

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matured into a patent. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 21-37 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 21 contain several deficiencies as shown below:

The claim fails to clearly recite relationship amongst the entities participating in the claimed method. Since, claim is intended to perform a purchase of good or service with use of (1) a quasi-public network (2) a computer system (3) the telephone network and (4) links as specified, each limitation of claim must clearly identify which of the aforementioned four elements are utilized in carrying out the respective process step.

For example: selecting step (a) fails to specify which network is used and who performs the selection of a purchase

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set, providing step (b) fails to clearly specify who does the providing of (i.e. a merchant computer or a customer computer?), no link of merchant (computer) to the transaction center is defined. Additionally, no the purchase set after selection (presumably by a customer using a customer computer) must be communicated to the selected merchant(s) (i.e. merchant computer(s)) if the selected purchase set is to be provided to the transaction center from each merchant in merchant set.

Step (c) fails to recite where "a set of registered customers" (more properly a set of identification data of registered customers) and associated set of personal information is received from. also this step has no direct relationship to other steps of the claim. Step (d) fails to recite what creating a payment instruction has to do with a telephone number identifiable by the telephone network. If the claim intends to recite the payment instruction based upon the personal information and identification data of customers registered with the transaction center in combination of the telephone number identified, it must be clearly recited. However, the claim in the present form fails to do so. Step (d) also fails to clearly recite that a paid set is also created as distinct from the payment instruction set. This is required for step (e)

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communicating..said paid set from the transaction center to the customer.

Step (f) lack antecedent basis for limitations of the claim. Nowhere "payment information" and "delivery information" is recited (created or communicated from) prior to this step.

Appropriate corrections are required.

Dependent claims 22-32 and 37 also inherit deficiencies of parent claim 21.

7. Claim 33, recites in preamble "electronic transaction center coupled to a quasi-public network and coupled to the telephone network", however, the claimed invention fails to clearly what other devices are connected to these networks the perform the recited steps. For example, limitation "creating a registered customer record..supplied by a customer", fails to identify any communication link of the customer with the electronic transaction center. Similarly, limitation receiving steps fail to show any relationship of the merchant and the customer to the transaction center. Wherever, an entity other than the transaction center is indicated, it is necessary to show relationship (i.e. communication means) of that entity to the transaction center, example: customer, merchant, third party.



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8. Claims 34 and dependent claims 35-36 also carry deficiency similar to claim 33. The claims have been analyzed in the present form without any patentable weight given to the preamble.

Further, the limitations "whereby.." in the end paragraph of independent claims 21, 33 and 34 claim purported benefits of the claimed invention in a narrative form without further limiting respective claims. Therefore, these limitations are not afforded any patentable weight.

***Claim Rejections - 35 USC § 102***

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

10. Claims 34-36 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Chelliah (US Pat. 5,710,887) (Chelliah).

Chelliah recites a method of operating a merchant's computer system coupled to a quasi-public network and the

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telephone network (refer to col. 6 as applies to Fig. 1, lines 31-36, the user interface may be a personal computer,.. a touch tone telephone..) comprising the steps of:

Receiving a customer's selection.. (col. 9 L 54-61, noting that inherently the customer interacts with the system 10 to make purchase selections, see also col. 12 for details);

Sending to a transaction center over a quasi-public network the purchase set the customer desires to purchase (the transaction center is the system (internal commerce subsystem 16) where the customer is allowed access via a store front interface connected to the transaction system via the Internet, see col. 6, see also col. 12 L 1-9 for details);

Receiving payment and delivery information for said customer from said transaction center (total cost information is returned to sales representative program col. 15, L 5-32 this information is also provided to the customer)

Claims 35 and 36: refer to col. 12 L 1-9, which reads..customer contact system 140 may be ..WWW site on the Internet..

### **Conclusion**

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

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Dogett in US Pat. 5,677,955 disclose an electronic instrument is created in a computer-based method for effecting a transfer of funds from an account of a payer in a funds-holding institution to a payee. The electronic instrument includes an electronic signature of the payer, digital representations of payment instructions, the identity of the payer, the identity of the payee, and the identity of the funds-holding institution.

Hogan in US Pat. 5,692,132 discloses a commercial transaction system, a system user uses a personal computer to interact with merchant computers over the Internet to conduct cashless transactions. Each system user computer processes data including a balance stored in the computer's memory and updates the stored data at the end of the transaction.

Tozoli et al. In US Pat. 5,717,989 discloses a system which criteria specified by a funder relating to trade transactions for buyers and sellers. The system compares the criteria with a proposed purchase order to determine whether the system can generate a payment guarantee on behalf of the funder for the buyer to the seller.

Bezos (US Pat. 5,727,163) A method and system for placing an order charged to a credit card, over an unsecured network. The customer completing an order for goods or services enters information required for the order, such as the shipping and billing addresses and identification of the goods, but enters only a subset of the credit card account number to which the order is to be charged. During a subsequent telephone call to the remote merchant location, the customer enters the complete credit card number, preferably on a touch-tone keypad (28). The touch-tone signals are processed by an automated attendant system (44) for input of the complete credit card number into the computer.

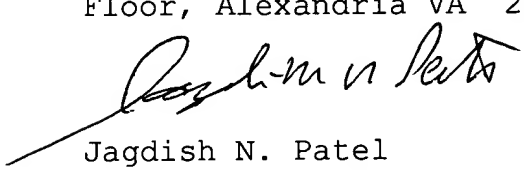
12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jagdish Patel whose telephone number is (703) 308-7837. The examiner can normally be reached Monday-Thursday from 8:00 AM to 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin, can be reached at (703) 308-1038. The fax number for Formal or Official faxes to Technology Center 3600 is (703) 305-7687. **Draft faxes may be submitted directly to the examiner at (703) 746-5563.**

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist

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whose telephone number is (703) 308-1113 or 308-1114. Address  
for hand delivery is 2451 Crystal Drive, Crystal Park 5, 7<sup>th</sup>  
Floor, Alexandria VA 22202.



Jagdish N. Patel

(Examiner, AU 3624)

7-14-03